

## **REMARKS/ARGUMENTS**

### **I) Entry of Previous Submissions**

Applicant notes that an acknowledgement was made by the Office of receipt of the remarks submitted on 9/19/03 but that they have not been commented on in the present Office Action. Therefore, Applicant understands that those remarks to not bear on the present claims.

Applicant acknowledges with thanks the entry of the submission filed on 12/11/03.

In this response, Claims 24-28 are cancelled without prejudice to reinstatement.

### **II) Rejections Under Section 102**

Claims 1, 8-12, and 17-23 were rejected under 35 USC Section 102(b) as being anticipated by Berson (US 5,598,477). The rejection is traversed.

First, it should be noted that claims 8 through 12 are dependent on claim 1, and claims 18 through 23 are dependent on claim 17.

Claim 1 has been amended to read, in part, as follows:

means for transmitting a ticket to a customer-selectable [remote] device remote from the customer independent of ticket printing authorization from the system for creating a ticket, . . .

The current amendment is for clarification purposes, is not related to patentability, and is not believed to significantly change the scope of claim 1 from the unamended claim.

Claim 1 specifically recites that the device is “remote” from the customer. Berson, returns ticket information to a printing system 20 that is “local” to the customer – according to the interpretation given to Berson in the outstanding Office Action. Therefore, claim 1 is not anticipated by Berson. Likewise, claims 8-12, which depend from claim 1, are not anticipated by Berson. Withdrawal of the rejections of claims 1, and 8-12 under Section 102 is requested.

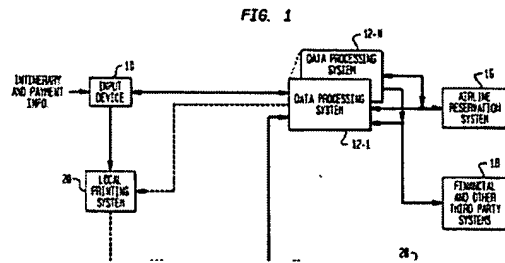
Claim 17 has been amended to add emphasis that the customer, according to Claim 17, is accessing the database through a public network, such as the internet, and that the printing is “selected by and remote from” the customer. Berson must be interpreted as some form of dial-in, direct connection. Berson, on the other hand, filed in 1994, never mentioning a public network and fails to teach these limitations. For example, the “local” printer of Berson is

local to the input device 10 in Figure 1, which is a device said to be suitable for input into data processing system 12-1. Berson fails to teach that the input device is in communication via a public network with the data processing

system 12-1. Berson's data processing system, on the other hand, communicates over a network (again non-public, given the technology of the day) to an airline reservation system or financial and other third-party systems.

Further still, although the Berson local printer could be a fax machine, there is nothing in Berson that teaches that the device that provides delivery information is selected by the customer and can be remote from the customer.

In summary, the limitations of claim 17 are not met by Berson; claim 17 is not anticipated, and the rejection should be withdrawn. Likewise, the rejection of claims 18-23 as being anticipated by Berson should be withdrawn.



### III) Rejections Under Section 103

#### A. Requirements of a Rejection Under Section 103.

To establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art. MPEP Section 2143.03, citing, *In re Royka*, 490 F.2d 981 (CCPA 1974). Or, said another way:

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

*Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Just because references *can* be combined or modified does not make the combination obvious unless *the prior art* also suggests the "desirability" of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Even though a prior art system "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682. See also, MPEP Section 2144.01.

The teaching or suggestion to make the claimed combination *and* the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. MPEP Section 2143, citing, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Further, "all teachings in the prior art must be considered to the extent that they are in analogous arts." MPEP Section 2143.01.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Office to explain why the combination of the teachings is proper. MPEP Section 2142, citing, *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). Although the rationale to modify or combine the prior art does not have to be expressly stated in the prior art under *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), the Office may not take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. MPEP Section 2144.03. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. MPEP Section 2144.03, citing, *Zurko*, 258 F.3d at 1385 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

Further, when a modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). See also, MPEP Section 2143.01. Further still, if the proposed modification or combination would change the principle of operation of one of the references, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) (prior art taught the device required rigidity the claimed invention required resiliency; the combination of references would require a change in the basic principle the construction was designed to operate).

A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness, and "it is improper to combine references where the references teach away from their combination." MPEP Section 2145, citing, *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). "The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness." MPEP Section 2145, citing *In re Hedges*, 783 F.2d 1038 (Fed. Cir. 1986).

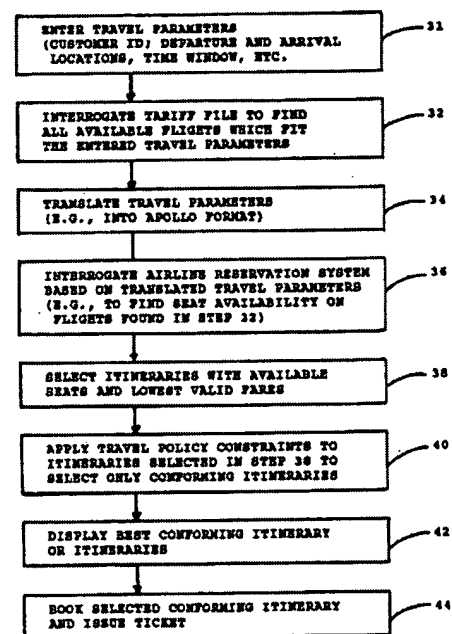
### B. Claims 2-6 and 3-16

Claims 2-6 and 3-16 were rejected over Webber in view of Berson. The rejection is traversed.

As agreed by the Examiner, Webber fails to disclose "a customer-selected printer independent of ticket printing authorization from the ticketing database or the venue database." In fact, Webber teaches against such a system in column 7, lines 1-3. Referring to Figure 2 (opposite), Webber says: "a ticket can be issued at a printer at an entry device *if the device is operated by a facility authorized to issue tickets.*" (emphasis added).

The most recent Office Action appears to rely on Berson for the missing element; however, it does not indicate a place in Berson where the limitation that is admittedly missing from Webber is located. Further, Applicant submits that the Berson "local printing system" is local to the data processor; therefore, there is no teaching of the independence limitation, and the suggested combination fails to result in all of the limitations of claim 2.

Further, still, there is no showing of any expectation of success in the prior art or even that the combination would be desirable, and as mentioned above, Webber teaches *away from* the combination.



In summary, under the authority cited above, the rejection of claims 2 through 6 and 3 through 16 are not unpatentable over Webber in view of Berson, and removal of the rejection is requested.

**C. Claims 29-36**

Claims 29-36 were rejected as being unpatentable over Webber/Berson in view of Rosen. The rejection is traversed.

As noted in the rejection, on page 5, Webber and Berson both lack the teaching “whereby the ticket is usable by a ticket bearer without regard to the particular customer to which the particular seat is bound.” Rosen was cited as having supplied that element; however, Applicant continues to assert that Rosen actually teaches away from the particular claim element in question.

The portion of Rosen cited (Col. 26, lines 1-7) should not be read out of context. The preceding sentences state that the transfer has to be through “trusted agents” and the subsequent many paragraphs describe a very cumbersome transfer process. None is needed in the invention as claimed in claim 29. Nothing in the prior art shows the combination suggested, and the “knowledge generally available” has not been shown, as required under the law (MPEP Section 2144.03; *In re Rouffet*, 149 F.3d at 1357), to add the missing elements. Further still, the suggested combination would destroy the use of the trusted agents and the alleged security benefits Rosen touts. Therefore, the suggested combination is improper. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Even further, the limitation of being able to have the printer being remote from the purchaser has been added. No combination of references can be properly made to show all of the elements of claim 29 as now amended.

Therefore, claims 29-36 are not unpatentable over the cited references, and withdrawal of the rejection is requested.

The Commissioner is hereby authorized to charge Deposit Account No. 01-2511 for any underpayment of the fees required under 37 CFR §§ 1.16 – 1.17, or credit the account for any overpayment.

Respectfully submitted,

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